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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/020,759
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	Art Unit	3622
	Examiner Name	Khahn H. Le
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Galloway

Application No.: 10/020,759

Filed: 12/13/2001

Title: Improved Methods for Enhancing Broadcast Media Advertising

Attorney Docket No.: 50046

Art Unit: 3622

Examiner: Khahn H. Le

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

MAILED March 23, 2007

REMARKS- SUMMATION

The Examiner's substantive comments in the Answer, pages 3-15, track the Final Office Action. The Examiner's comments in "(10) Response to (Briefs) Arguments," beginning middle of page 15 through the top of page 17, do not reference the claims and the specification of SN 10/020,759, the application under appeal. They appear to reference the claims and specification of the parent. Notwithstanding, the Examiner's position appears to be paraphrasable as:

The invention is merely providing an automatic means to replace a manual activity (AAPA, spec. para. [0006]), which accomplishes the same result (no surprising results and no unexpected results.)

Rogers teaches the 'automation means' limitation, as 'claim 1 boils down only to accessing a database record, ...,' because claim language 'indicating, directly or indirectly, at least times for ads broadcast in a past period' is "non-functional descriptive material" and is not to be given patentable weight.

Alternately, the invention is obvious to an experienced TBS software crafter with knowledge of various TBS systems, asserted to be the person of ordinary skill in the art.

(This is Applicant's interpretation of the Examiner's position and, of course, is non-binding on the Examiner.)

Clarification re Alleged "Non-functional Descriptive Material"

Records “indicating, directly or indirectly, at least times for ads broadcast in a past period” should be given patentable weight. The words indicate which record, what sort of record, is to be accessed. Thus, the independent claims recite electronically accessing specific stored records, records indicating times for ads broadcast in a past period. To applicant’s knowledge at the time of filing, this record was only available within a traffic and billing system and/or broadcaster inserter equipment. The claim words were intended to, and applicant asserts do thus, have functional significance. They identify records by function rather than identify the records by the name of a system creating them. (In fact, in dependent claims the record is identified also by the name of the system creating it. The Examiner, however, appears also not to accord that identification patentable weight either.) The independent claims were so written because conceivably all traffic and billing systems might not call themselves “traffic and billing systems” and/or all broadcaster inserter equipment might not call themselves “broadcaster inserter equipment.” Thus, applicant traverses the Examiner’s “boils down to” analysis (Ans page 16, last 2 lines) and the Examiner’s concomitant conclusion flowing therefrom, (bottom of page 17) ergo that “the technology capable of doing the automated step was available” (E.g. Rogers.)

Re TBS Records

The Examiner produces no evidence that Rogers taught or suggested the capability of accessing records of a traffic and billing system and/or of broadcaster inserter equipment. The Examiner does not produce evidence that all electronically stored records are necessarily accessible by Rogers’ means, or that all electronically stored records are fungible. One would expect not. Rogers does not explicitly teach or suggest technology capable of electronically accessing a TBS (or inserter equipment) record, and thus does not teach or suggest technology capable of generating a client report including “at least a time for a broadcast of an ad in a period.”

The instant invention is concerned with records created by special purpose software written to operate a specific business on special hardware. As previously argued, to applicant’s knowledge there are only a dozen or so products of this type on the market in the US. Rogers does not teach or suggest accessing their databases. The “automatic means” limitation, thus, is not disclosed in Rogers.

Invention Not “Simple Automation”

Even for the inventor, who should be deemed to be of more than ordinary skill in the art, electronically accessing requisite records required extensive experimentation and testing to determine if it could be done, and timely and safely done. Whether a client report could be effectively automated was not known, and it was not obvious, even to the instant inventor. What was involved in the instant invention was not “simple automation.” A TBS is designed to run a broadcast business and is designed

to interface with broadcast inserter equipment in order to schedule ads and produce bills. The effort to produce automated client reports could involve a risk of disturbance of the TBS system. The instant inventor, to illustrate some issues, had to research TBS and broadcast inserter equipment manuals and limitedly experiment in order to determine if adequate information were available and discoverable as to where particular records were stored and formats for the records. The inventor had to perform this task for a plurality of TBS systems. The inventor had to determine whether records could be located that, as stored, were addressable and copyable. The inventor had to determine that a reliable non-interfering (not interfering with either TBS operation or broadcast inserter equipment operation) time window existed in which to perform an address and copy operation.

Prior Art a Failure, Teaches Away

Re the AAPA, the AAPA, in one perspective, can be viewed as teaching away from the Examiner's position. If it were "obvious" to automate the prior manual efforts to generate and transmit a time/ad client report, the AAPA would have done so.

The Examiner does not establish that any report that can be "downloaded" can be "electronically accessed."

The AAPA can be viewed as a failure by others. The manual method was so time and labor intensive that it never received exposure. It was a failure. The surprising value of automated client reports was not made obvious by AAPA due to the method's inherent limitations.

Re Surprising Unexpected Results

The automated client report in fact produced unexpected and enhanced results. The results were unexpected in terms of the goodwill created by their reception and unexpected in terms of the demand therefore. E.g. as previously argued (1) the automatically generated and transmitted client reports, including at least a time for a broadcast of an ad in a period, were accorded unexpectedly high value by advertising clients. (2) The automatic means to generate and transmit a client report was unexpectedly safely created and tested. (3) The general cost effectiveness, reliability and availability of the automated report offered a substantially enhanced product over time consuming, limited manually produced reports of AAPA. The "automated means" produced an enhanced and surprising result, not the same or obvious result of the AAPA.

Re the Person of Ordinary Skill

The Examiner's apparent alternate position, that of construing the person of ordinary skill in the art as an experienced TBS software crafter with experience of various systems, looks not to the art or the field in which the invention arose. The Examiner does not cite the education levels, skills, talents or job

descriptions of the people filling the role of the inventor. The Examiner, rather, posits a person with the a priori necessary technical skills (e.g. experienced creators of TBS systems having familiarity with a plurality of such systems) such that, by definition, the claim steps would have been obvious. (Not, one might say, the motive to produce the product, or the value of the product, but the skill to implement the vision.)

Applicant respectfully traverses. Evidence of the specific skills of such person and of what would be obvious to such person is not explicitly presented; the level of skill is presumed, in a result determinative fashion. There is no evidence that those in the world of crafting TBS software with experience of various TBS systems would be in position to envision the value of automated client reports. That they did not argues to the contrary. There is no evidence that such persons were in position to appreciate the inventor's problem or his solution, or that they were in position to be motivated to create his product. The commercial reality is that experienced TBS software creators are experts in their own field, which field in turn has its own agendas, problems and priorities.

Re KSR International Co.- Four Points

I. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, April 30, 2007, page 13 of 2007 WL 1237837, recently recites:

- (1) "When there is a design need or market pressure to solve a problem, and
- (2) there are a finite number of identified, predictable solutions,
- a person of ordinary skill has good reason to pursue
- (3) the known options within his/her technical grasp."

(Formatting and numbering supplied.)

Considering the instant case in light of the above, an operations manager for broadcast media could have been sensitive to "a design need or market pressure to solve a problem" – i.e. giving advertising clients better information, grasp and feeling about what they purchased with their advertising money. An experienced TBS software crafter would not have been sensitive to such design need or market pressure. Rogers would not have been sensitive to that design need or market pressure.

The above comment being recent, no discussion has taken place regarding "a finite number of identified predictable solutions." Applicant can submit, however, that there are a variety of potential paths for solving the problem, each path offering variations. One class of solutions to applicant's problem would lie in altering the advertising contracts such that they produced predictable results within certain time frames. One such solution could implement periodically changing addendums to a contract, for instance, the addendums changing every week or few weeks. The addendums could be generated by a computer in accordance with a formula. Each addendum for the next period could yield a specific

advertising schedule for the client. Another class of potential solutions lies in ordering and organizing the TBS such that it rigidly followed an ordered priority of algorithms in assigning advertising space for permitted contracts. The result of that arrangement could be that, for a given a specific set of permitted contracts, applying the rigid algorithm priority system resulted in an advertising schedule that could be predicted for a contract, at least for a given future period.

Applicant does not claim to have exhausted the class of predictable solutions by the suggestions above. Applicant illustrates some immediate candidates for solutions.

The actual option selected by the instant inventor, to electronically access records created in a relevant time period by TBS and/or a broadcast inserter equipment system, generally exceeds the “technical grasp” of the person of ordinary skill in the pertinent art, that of an operations manager for broadcast media. The option exceeds the “technical grasp” in terms of assessing a likelihood of success, assessing a risk of harm to existing systems and assessing the degree of necessary complexity involved. In the instant case the inventor doggedly pursued this option, with good fortune it turns out, and to a successful conclusion, which was by no means obvious. Innovation was added to the field.

II. Further, the instant invention does not just “combine familiar elements” according to “known methods,” again *id* at page 11. At the time of the invention there was no known method (to one of ordinary skill in the pertinent art) for electronically accessing time/ad broadcast information from the records created by an a TBS system and/or broadcast inserter equipment.

III. Applicant submits that the evidence submitted of commercial success, failure of others and copying should at least be properly utilized “to give light to the circumstances surrounding the origin of the subject matter sought to patented.” *KSR International Co.*, at page 7, quoting from *Hotchkiss v. Greenwood*.

IV. Potentially also on point from the above case, *KSR International Co.* recites on page 12:

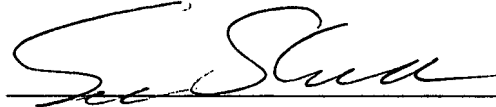
“When work is available for one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious **unless its actual application is beyond his or her skill.**”

Electronically accessing the needed records of a TBS and/or broadcast inserter equipment is beyond the skill of a person of ordinary skill in the pertinent art, the operations manager. The Supreme Court does not say that in the case of different fields, the person of ordinary skill is deemed to have the capabilities of the person of ordinary skill in both fields of endeavor.

Respectfully Submitted,

5/22/7

Date



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